

REMARKS

Upon entry of this Amendment, claims 1-30, 33, and 34 will remain pending and under current examination. Applicant respectfully requests reconsideration of this application in light of the following remarks.

In the Office Action,¹ the Examiner rejected claims 1, 8, and 24 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent Publication No. 2004/0203385 to Narayanan et al. (“*Narayanan*”); rejected claims 2-7, 9-16, 18, 19, 21, 23, and 25-34² under U.S.C. § 103(a) as unpatentable over *Narayanan* in view of U.S. Patent Publication No. 2003/0110297 to Tabatabai et al. (“*Tabatabai*”); and rejected claims 17, 20, and 22 under U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*, and further in view of U.S. Patent No. 6,351,647 to Gustafsson (“*Gustafsson*”). Applicant respectfully traverses the Examiner’s rejections for the following reasons.

I. Regarding the rejection of claims 1, 8, and 24 under 35 U.S.C § 102(e) as anticipated by *Narayanan*

Applicant respectfully traverses the rejection of claims 1, 8, and 24 under 35 U.S.C. § 102(e) as anticipated by *Narayanan*. In order to properly establish that *Narayanan* anticipates Applicant’s claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, “[t]he identical

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

² The Examiner indicates in the heading on page 3 of the Office Action that claims 2-7, 9-23, and 25-34 are rejected under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*. However, no rejection of claims 17, 20, and 22 are provided on these grounds. Accordingly, Applicant assumes that the heading on page 3 is a typographical error.

invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Narayanan does not disclose each and every element of Applicant's claimed invention. Claim 1, as amended, calls for a combination including, for example,

receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of a first capability and a second capability present in the first wireless terminal;

determining whether the second wireless terminal has the first capability and the second capability; and

establishing the communication between the first wireless terminal and the second wireless terminal using the first capability, when it is determined that the second wireless terminal has the first capability but does not have the second capability

(emphasis added). *Narayanan* fails to teach or suggest at least these elements of claim 1.

The cited portions of *Narayanan* teach transferring "a video signal from the telephone 114 to the television 116" and techniques for performing "device discovery" to establish the transfer if a device can support the transfer (*Narayanan*, paragraphs 0016 and 0017). *Narayanan* simply determines if the television 116 can receive a video signal transferred from telephone 114. If the television cannot, no transfer is made. Such teachings by *Narayanan* do not constitute a teaching or suggestion of

receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of a first capability and a second capability present in the first wireless terminal;

determining whether the second wireless terminal has the first capability and the second capability; and

establishing the communication between the first wireless terminal and the second wireless terminal using the first capability, when it is determined that the second wireless terminal has the first capability but does not have the second capability

(emphasis added) as recited by claim 1. Accordingly, *Narayanan* cannot anticipate claim 1. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claim 1 under 35 U.S.C. § 102(e) as anticipated by *Narayanan*.

Amended independent claim 8, although of different scope, recites elements similar to elements of claim 1 and is therefore allowable at least for the reasons discussed above. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of independent claims 1 and 8 under 35 U.S.C. § 102(e) as anticipated by *Narayanan*.

Independent claim 24 recites a combination including

A method for establishing communications between a first mobile phone that is capable of supporting video telephony and a second mobile phone that is not capable of supporting video telephony, the method comprising:

receiving a signal from the first mobile phone to establish a video telephony call between the first mobile phone and the second mobile phone; and

determining that the second mobile phone is not capable of supporting the video telephony call;

splitting the video telephony call into two streams, the first stream being a voice only stream and the second stream being a video stream; and

establishing the call between the first mobile phone and the second mobile phone by forwarding only the first stream to the second mobile phone

(emphasis added). *Narayanan* fails to teach or suggest these elements recited by independent claim 24, as amended. Accordingly, *Narayanan* cannot anticipate claim

24. Applicant therefore respectfully requests the Examiner to reconsider and withdraw the rejection of claim 24 under 35 U.S.C. § 102(e) as being anticipated by *Narayanan*.

II. Regarding the rejection of claims 2-7, 9-16, 18, 19, 21, 23, and 25-34 under U.S.C. § 103(a) as being unpatentable over *Narayanan* in view of *Tabatabai*

Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 2-7, 9-16, 18, 19, 21, 23, and 25-34 because a *prima facie* case of obviousness has not been established with respect to these claims.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 2 (May 2004), p. 2100-128.

A *prima facie* case of obviousness has not been established because, among other things, neither *Narayanan* nor *Tabatabai*, taken alone or in combination, teaches or suggests each and every element of Applicant's claims.

Claims 2-7, 9-14, and 25-32 depend from claims 1, 8, and 24 respectively, and therefore include all of the elements recited therein. As noted above, *Narayanan* fails to teach or suggest at least

receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of a first capability and a second capability present in the first wireless terminal;

determining whether the second wireless terminal has the first capability and the second capability; and

establishing the communication between the first wireless terminal and the second wireless terminal using the first capability, when it is determined that the second wireless terminal has the first capability but does not have the second capability

(emphasis added) as recited by claims 1 and 8 and required by dependent claims 2-7 and 9-14. *Tabatabai* fails to cure the deficiencies of *Narayanan* discussed above.

Tabatabai merely teaches adapting “media data … so that the multimedia presentation may be played on a target device” (*Tabatabai*, paragraph 21). However, this does not constitute a teaching or suggestion of

receiving a signal from the first wireless terminal to establish a communication between the first wireless terminal and the second wireless terminal, wherein the communication includes use of a first capability and a second capability present in the first wireless terminal;

determining whether the second wireless terminal has the first capability and the second capability; and

establishing the communication between the first wireless terminal and the second wireless terminal using the first capability, when it is determined that the second wireless terminal has the first capability but does not have the second capability

(emphasis added), as required by dependent claims 2-7 and 9-14. Because neither *Narayanan* nor *Tabatabai*, taken alone or in combination, teaches or suggests each and every element required by dependent claims 2-7 and 9-14, no *prima facie* case of obviousness has been established for these claims. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of dependent claims 2-7 and 9-14 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

With respect to dependent claims 25-32, as discussed above, *Narayanan* fails to teach or suggest

A method for establishing communications between a first mobile phone that is capable of supporting video telephony and a second mobile phone that is not capable of supporting video telephony, the method comprising:

- receiving a signal from the first mobile phone to establish a video telephony call between the first mobile phone and the second mobile phone; and
- determining that the second mobile phone is not capable of supporting the video telephony call;
- splitting the video telephony call into two streams, the first stream being a voice only stream and the second stream being a video stream; and
- establishing the call between the first mobile phone and the second mobile phone by forwarding only the first stream to the second mobile phone

(emphasis added) as recited by claim 24 and required by dependent claims 25-32.

Tabatabai fails to cure the deficiencies of *Narayanan*. Because neither *Narayanan* nor *Tabatabai*, taken alone or in combination, teaches or suggests each and every element required by claims 25-32, no *prima facie* case of obviousness has been established for these claims. Accordingly, Applicant respectfully requests the Examiner to withdraw the rejection of claims 25-32 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Independent claim 15 recites a combination including, for example,

- querying a database to determine whether the second wireless terminal has video capability;
- if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway;
- setting up a video session between the first wireless terminal and a video server; and
- setting up a non-video session between the first wireless terminal and the second wireless terminal.

(emphasis added). The Examiner concedes that *Narayanan* does not or suggest at least these elements (Office Action at p. 6). To cure these deficiencies, the Examiner

asserts “see *Tabatabai* (pages 2-3, [0021-0027])” (Office Action at p. 6). The cited portions of *Tabatabai* fail to cure the deficiencies of *Narayanan*.

Tabatabai merely teaches adapting “media data … so that the multimedia presentation may be played on a target device” (*Tabatabai*, paragraph 21). *Tabatabai* does not teach or suggest a “database” or “querying a database to determine whether the second wireless terminal has video capability,” as recited by claim 15. Further, *Tabatabai* does not teach or suggest “if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway,” as recited by claim 15. In addition, *Tabatabai* does not teach or suggest “setting up a video session between the first wireless terminal and a video server,” as recited by claim 15. Moreover, *Tabatabai* does not teach or suggest “setting up a non-video session between the first wireless terminal and the second wireless terminal,” as recited by claim 15.

Because *Narayanan* and *Tabatabai*, taken alone or in combination, do not teach or suggest each and every element recited by claim 15, no *prima facia* case of obviousness has been established for this claim. Independent claims 18 and 21, although of different scope, recite elements similar to elements recited by independent claim 15. Accordingly, for at least the reasons discussed above regarding independent claim 15, no *prima facie* case of obviousness has been established with respect to claims 18 and 21. Therefore, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection of claims 15, 18, and 21 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Claims 16 and 19 depend from independent claims 15 and 18, respectively, and include all of the elements recited therein. Accordingly, for at least the reasons discussed above, no *prima facie* case of obviousness has been established with respect to claims 16 and 19. Moreover, neither *Narayanan* nor *Tabatabai*, taken alone or in combination, teaches or suggests at least “playing a video announcement for the first wireless terminal informing the first wireless terminal of a lack of the video capability in the second wireless terminal,” as recited by claims 16 and 19. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 16 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Moreover, in rejecting claim 21, the Examiner asserts that *Narayanan* discloses the claimed elements in “(col. 1, line 54 to col. 2, line 9 and col. 3, line 66 to col. 4, line 25)” (Office Action at p. 7). This citation appears to be an error. *Narayanan* does not contain “columns” (it is a publication), and the cited portions of *Narayanan* are not related to elements recited by claim 21. Rather, the Examiner’s citation appears to be from the previous Office Action and appears to be directed to the *Tung* reference, which is not relied on in the outstanding Office Action (see Office Action mailed April 4, 2005 at p. 7). To illustrate, the Examiner asserts that *Narayanan* teaches “a home location register and a visitor location register” in the incorrect citation regarding claim 21. However, the Examiner concedes that *Narayanan* does not teach or suggest “a home location register and a visitor location register” in rejecting claims 17, 20, and 22 (Office Action at p. 7).

Moreover, the Examiner has not indicated how *Tabatabai* allegedly applies to the elements recited by claim 21, nor provided any motivation to combine *Tabatabai* with

Narayanan. For at least these additional reasons, no *prima facie* case of obviousness has been established with respect to claim 21. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 21 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Because the Examiner has not addressed how *Narayanan* or *Tabatabai*, taken alone or in combination, allegedly teach or suggest the elements recited by claim 21, Applicant respectfully request that any subsequent Office Action containing a rejection of claim 21 be made non-final.

Claim 23 depends from independent claim 21 and therefore includes all of the elements recited therein. Accordingly, for at least the reasons discussed above regarding independent claim 21, no *prima facie* case of obviousness has been established with respect to claim 23. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 23 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Independent claim 33 recites a combination including, for example, “establishing a new call between an originating terminal and a terminating terminal, the new call reflecting call processing functionality available to the originating terminal regardless of call processing functionality available to the terminating terminal and invoked when placing the new call, such that any adjustments required to establish the new call are made if the new call requires specific call processing functionality not available to the terminating terminal” (emphasis added). Similar to the discussion of claims 1, 8, and 24 above, *Narayanan* does not teach or suggest such features. Moreover, *Tabatabai* fails to cure these deficiencies. Accordingly, because neither *Narayanan* nor *Tabatabai*,

taken alone or in combination, teaches or suggests each and every element recited by independent claim 33, no *prima facia* case of obviousness has been established with respect to this claim. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 33 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

Independent claim 34, although of different scope, recites similar elements to elements recited by independent claim 33. Accordingly, for at least the reasons discussed above with respect to claim 33, no *prima facia* case of obviousness has been established with respect to claim 34. Applicant therefore respectfully requests that the Examiner reconsider and withdraw the rejection of claim 34 under 35 U.S.C. § 103(a) as unpatentable over *Narayanan* in view of *Tabatabai*.

III. Regarding the rejection of claims 17, 20, and 22 under U.S.C. § 103(a) as being unpatentable over *Narayanan* and *Tabatabai* in view of *Gustafsson*

Claims 17, 20, and 22 depend from claims 15, 18, and 21 respectively, and therefore include all of the elements recited therein. As noted above, *Narayanan* and *Tabatabai* fail to teach or suggest at least

querying a database to determine whether the second wireless terminal has video capability;
if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway;
setting up a video session between the first wireless terminal and a video server; and
setting up a non-video session between the first wireless terminal and the second wireless terminal

(emphasis added), as recited by independent claim 15 required by dependent claim 17. Dependent claims 20 and 22 depend from independent claims 18 and 21, which,

although of different scope, recite similar elements to elements recited by independent claim 15.

Gustafsson fails to cure the deficiencies of *Narayanan* and *Tabatabai* discussed above. *Gustafsson* is relied upon for allegedly teaching “the database is at least one of a home location register and a visitor location register and wherein the at least one call processing module is resident in the at least one mobile switching center (col.2, lines 65 to col. 3, line 19)” (Office Action at p. 10). Even assuming the Examiner’s assertion is true, *Gustafsson* nevertheless fails to teach or suggest at least

querying a database to determine whether the second wireless terminal has video capability;

if the second wireless terminal does not have video capability, then forwarding the call signal to a video gateway;

setting up a video session between the first wireless terminal and a video server; and

setting up a non-video session between the first wireless terminal and the second wireless terminal

(emphasis added) as required by claims 17 and 20. Similarly, *Gustafsson* fails to teach or suggest at least “at least one call processing module for querying at least one of a home location register and a visitor location register to determine whether the second wireless terminal has a video capability, for setting up at least one video session between the first wireless terminal and a video server, and for setting up at least one non-video session between the first wireless terminal and the second wireless terminal,” as required by claim 22.

Because *Narayanan*, *Tabatabai*, and *Gustafsson*, taken alone or in combination, fail to teach or suggest each and every element required by claims 17, 20, and 22, no *prima facie* case of obviousness has been established for these claims. Accordingly,

Customer No. 22,852
Attorney Docket No. 08950.0003-00
Application No. 10/698,550

Applicant respectfully requests the Examiner to withdraw the rejection of claims 17, 20, and 22 as being unpatentable over *Narayanan* in view of *Tabatabai*, and further in view of *Gustaffson*.

IV. Conclusion

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Applicants respectfully request that the Examiner respond to every point raised herein in accordance with M.P.E.P. § 707.07(f). Should the Examiner continue to dispute the patentability of the claims after consideration of this Reply, Applicants encourage the Examiner to contact Applicants' undersigned representative by telephone to discuss any remaining issues or to resolve any misunderstandings.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 8, 2006

By: 
Nathan A. Sloan
Reg. No. 56,249
202.408.4312